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OFFICE OF PETITIONS

In re Application of :
Claudio R. BALLARD :
Application No. 09/454,492 : **ON PETITION**
Filed: December 6, 1999 :
Attorney Docket No. P43312 :

This is a decision on the petition filed March 5, 2010, under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3600 (Technology Center Director), dated December 15, 2009, which: (1) vacated the final Office action of July 15, 2009; (2) vacated the October 9, 2009 response to the July 15, 2009 final Office action; and (3) indicated that the application is abandoned for failure to file a timely response to the Restriction Requirement mailed January 14, 2009. The petition filed March 5, 2010 alternatively requests that the application be revived under the provisions of 37 CFR 1.137(b).

The petition to overturn the decision of the Technology Center Director dated December 15, 2009, is **GRANTED-IN-PART**.

The petition to revive the application under 37 CFR 1.137(b) is **GRANTED**.

RELEVANT BACKGROUND

On January 14, 2009, a Restriction Requirement was mailed.

On July 14, 2009, a letter was filed indicating the examiner had agreed to withdraw the January 14, 2009 Restriction Requirement and mail a new Office action.

On July 15, 2009, a final Office action was mailed.

On September 15, 2009, a petition under 37 CFR 1.181 to withdraw the finality of the July 15, 2009 Office action was filed.

On October 9, 2009, a response to the July 15, 2009 final Office action was filed.

On December 15, 2009, a decision dismissing the petition of September 15, 2009 as moot in view of the abandoned status of the application was mailed.

On March 15, 2010, a petition requesting review of the petition decision of December 15, 2009 was filed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. 133 states:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.111 states:

(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

37 CFR 1.135 states:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

37 CFR 1.143 states:

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

37 CFR 1.181(f) states:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

MPEP 502.03(II) states:

Where a written authorization is given by the applicant, communications via Internet e-mail, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used. In such case, a printed copy of the Internet e-mail communications **MUST** be given a paper number, entered into the Patent Application Locating and Monitoring System (PALM) and entered in the patent application file. A reply to an Office action may **NOT** be communicated by applicant to the USPTO via Internet e-mail. If such a reply is submitted by applicant via Internet e-mail, a paper copy will be placed in the appropriate patent application file with an indication that the reply is **NOT ENTERED**.

MPEP 711.03(a) states:

Applicant may deny that the reply was incomplete.

While the primary examiner has no authority to act upon an application in which no action by applicant was taken during the period for reply, he or she may reverse his or her holding as to whether or not an amendment received during such period was responsive and act on an application of such character which he or she has previously held abandoned. This is not a revival of an abandoned application but merely a holding that the application was never abandoned. See also MPEP § 714.03.

MPEP 818.03(a) states:

As shown by the first sentence of 37 CFR 1.143, the traverse to a requirement must be complete as required by 37 CFR 1.111(b) which reads in part: "In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. . . . The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. . . ." Under this rule, the applicant is required to specifically point out the reasons on which he or she bases his or her conclusions that a requirement to restrict is in error. A mere broad allegation that the requirement is in error does not comply with the requirement of 37 CFR § 1.111. Thus the required provisional election (see MPEP § 818.03(b)) becomes an election without traverse.

OPINION

With respect to the petition under 37 CFR 1.181

Petitioner specifically requests that the Director overturn the Technology Center Director's decision of December 15, 2009 and: (1) withdraw the holding of abandonment; (2) reinstate the July 15, 2009 Office action and accept the amendment filed October 9, 2009; and (3) direct the Technology Center Director to treat the September 15, 2009 petition.

This application was held abandoned for failure to timely file a proper reply on or before February 14, 2009, in response to the Restriction Requirement mailed January 14, 2009. A Notice of Abandonment was mailed on December 31, 2009.

Petitioner states: (1) a proper reply was timely filed, or in any event, (2) a proper reply to the outstanding restriction requirement was timely filed as evidenced by (a) the USPTO's own actions or inactions in this case, and (b) the documents already of record in this case, and (3) the [Technology Center Director's] Decision has improperly refused to accord any evidentiary force and effect to the e-mails issued by the PTO and Applicant. Petitioner specifically argues: (1) the restriction requirement had been repudiated, in writing, by two PTO officials through e-mail and implies that no other reply could have been prepared in this instance as the "complete and proper reply" was the e-mail correspondence; (2) the Examiner and SPE have authority to withdraw an action or requirement they themselves have issued and that the e-mail communication was in fact a timely withdrawal of the requirement; and (3) the examiner has the authority to withdraw the holding of abandonment in accordance with MPEP 711.03(a). However, a review of the record confirms that a proper reply was not timely filed on or before February 14, 2009.

While the USPTO does have an Electronic Office Action (e-Office Action) program (in which applicant has elected to participate), this should not be confused the Patent Internet Usage Policy of the USPTO which covers e-mail communications between applicant and the Office. The e-Office Action program is used to notify applicant by e-mail that an Office communication is retrievable through Private Patent Application Information Retrieval (PAIR) in lieu of paper mailings of the communication. As set forth in Item 14 of the USPTO's Electronic Office Action Policy at 1343 *Off. Gaz. Pat. Office* 49 (June 2, 2009):

14. Does the e-Office Action change the policy for communications via the Internet?

By registering for the e-Office Action program, participant is authorizing the Office to send e-mail notifications of Office communications entered by the participating Office business units in the applications associated with the Customer Number. The e-Office Action program does not, otherwise, change the policy for communications via the Internet set forth in the Manual of Patent Examining Procedure (MPEP) § 502.03.

The e-Office Action program does not alter the Office policy prohibiting an applicant or examiner from engaging in improper e-mail correspondence. **For example, applicant**

may not send a reply to an Office action to the Office via e-mail, and the examiner may not send an Office action to the applicant via e-mail. See MPEP § 502.03.
[Emphasis added]

It is clear from the USPTO's Electronic Office Action Policy that the USPTO does not permit Office actions or replies thereto to be sent via e-mail. Accordingly, the e-mail correspondence is not a complete and proper reply to the Restriction Requirement of January 14, 2009 or a timely response within the shortened statutory period for response (or any extended time period) set forth in the Restriction Requirement of January 14, 2009, nor is the e-mail communication from the examiner a timely withdrawal of the Restriction Requirement of January 14, 2009. Thus, applicant did not respond to the Restriction Requirement of January 14, 2009 nor did the USPTO withdraw or replace the requirement within the six-month period provided in 35 U.S.C. 133.

Furthermore, MPEP 502.03(II) and Article 5 of the Patent Internet Usage Policy of the USPTO at 64 FR 33060 (June 21, 1999) state:

Where a written, authorization is given by the applicant, communications via Internet e-mail, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used.

Therefore, as a signature is required to respond to an Office action, neither the USPTO's e-Office Action program nor the USPTO's Internet communication policy permit replies to an Office action by e-mail. Firstly, as set forth above, the e-mail communications do not meet the response requirements of 37 CFR 1.111, 37 CFR 1.143, and MPEP 818.03(a). Additionally, as a signature is required to withdraw an Office action or requirement and the e-mail communications are unsigned, the e-mail communications are not official communications from the Office and may not be used effect withdrawal of the Restriction Requirement of January 14, 2009. In any event, a review of the unofficial e-mail communications indicates that they do not purport to affect a withdrawal of the Restriction Requirement of January 14, 2009, but that they simply advise the applicant that the examiner intends to withdraw the Restriction Requirement of January 14, 2009. There is no comment, official or unofficial that actually purports to withdraw the Restriction Requirement of January 14, 2009 within the period for reply to the Restriction Requirement of January 14, 2009. The only inference that may be gleaned from the e-mails is that the examiner planned to withdraw the requirement at some future time, however, the examiner never withdrew the requirement within the time for doing so (*i.e.*, within the six-month period provided in 35 U.S.C. 133).

Additionally, MPEP 502.03(II) and Article 5 of the Patent Internet Usage Policy of the USPTO at 64 FR 33060 (June 21, 1999) state:

A reply to an Office action may **NOT** be communicated by applicant to the PTO via Internet e-mail. If such a reply is submitted by applicant via Internet e-mail, a paper copy will be placed in the appropriate patent application file with an indication that the reply is **NOT ENTERED**.

Accordingly, the e-mail communications relied upon by petitioner is not a timely complete and proper reply to the Restriction Requirement of January 14, 2009. Additionally, the examiner's e-mail response to petitioner's e-mail is not a timely withdrawal of the requirement. As set forth in 35 U.S.C. 133 upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

In any event, a proper reply to the Restriction Requirement of January 14, 2009 must have been reduced in writing and specifically point out the reasons on which he or she bases his or her conclusions that a requirement to restrict is in error. A mere broad allegation that the requirement is in error does not comply with the requirement of 37 CFR 1.111. See 37 CFR 1.143; MPEP 818.03(a), *supra*. As the e-mail communications do not comply with the requirements of 37 CFR 1.111, 37 CFR 1.143 and MPEP 818.03(a), they are not a proper response to the Restriction Requirement.

Additionally, while petitioner argues that MPEP 711.03(a) permits the examiner to withdraw the holding of abandonment, that is not the case. MPEP 711.03(a) permits an examiner to reverse his or her holding as to whether or not an amendment received during the period for reply was responsive and act on an application of such character which he or she has previously held abandoned, *i.e.*, hold that the application was never abandoned. In this case no reply was received during the period for reply. Therefore, the examiner had no authority to act on the application after July 14, 2009.

For the reasons set forth above, petitioner's request to withdraw the holding of abandonment is denied.

With respect to the petition under 37 CFR 1.137(b)

Petitioner's request to revive the above-identified application under the provisions of 37 CFR 1.137(b) is granted.

This decision hereby ratifies the prosecution of the instant application which occurred between February 15, 2009 and the mailing date of this decision. Accordingly, the Office action mailed July 15, 2009 is reinstated and the response filed October 9, 2009 is accepted.

The application file is being forwarded to Technology Center 3600 for treatment on the merits of the petition filed September 15, 2009.

DECISION

A review of the record indicates that the Technology Center Director did not abuse his discretion or act in an arbitrary and capricious manner in the petition decision of December 15, 2009. The record establishes that the Technology Center Director had a reasonable basis to support his findings and conclusion.

The petition is granted to the extent that the decision of the Technology Center Director of December 15, 2009 has been reviewed, but is denied with respect to withdrawing the holding of abandonment.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099

A handwritten signature in black ink, appearing to read 'RWB', with a long horizontal stroke extending to the right.

Robert W. Bahr
Acting Associate Commissioner
For Patent Examination Policy